



SEP 5 2001

In re

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:
: DECISION ON
: PETITION FOR REGRADE
: UNDER 37 C.F.R. § 10.7(c)
:

MEMORANDUM AND ORDER

(petitioner) petitions for regrading his answers to questions 6, 8, 17, 37, 43, 46 and 48 of the morning section and questions 4, 8, 17, 20, 40 and 43 of the afternoon section of the Registration Examination held on October 18, 2000. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 66. On December 8, 2000, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made

regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

OPINION

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: " No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the Official Gazette. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which

will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions.

Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been awarded an additional point for morning question 6. Accordingly, petitioner has been granted an additional point on the Examination. No credit has been awarded for morning questions 8, 17, 37, 43, 46 and 48 and afternoon questions 4, 8, 17, 20, 40 and 43. Petitioner's arguments for these questions are addressed individually below.

Morning question 8 reads as follows:

8. Which of the following is true?

- (A) If after the filing of a reissue application no errors in the original patent are found, a reissue patent will be granted on the reissue application noting no change, and the original patent will be returned to the applicant.
- (B) In order to add matter not previously found in the patent, a continuation-in-part reissue application must be filed.
- (C) In a reissue application, additions and deletions to the original patent should be made by underlining and bracketing, respectively, except for changes made in prior Certificates of Correction and disclaimer(s) of claims under 37 C.F.R. §1.321(a).
- (D) A dependent claim may be broadened in a reissue application only in the first two years of the enforceable life of the patent.
- (E) (A), (B), and (C).

The model answer is selection C.

See MPEP § 1411.01. As to (A) see MPEP § 1402. A reissue patent is not granted. As to (B), new matter may not be entered in a reissue. As to (D) see MPEP § 1412.03, p.1400-13. Since (A), and (B) are incorrect, (E) is incorrect.

Petitioner argues that answer (D) is correct. Petitioner contends that where a dependent claim is broadened because its precedent independent claim is broadened, this may only be done in the first two years.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that where a dependent claim is broadened because its precedent independent claim is broadened, this may only be done in the first two years, selection (D) only refers to a dependent claim and makes no reference to independent claims. There is no reason to assume that any independent claim was broadened. Selection (D)'s 'only' clause implies that a dependent claim may never be broadened in a reissue application after the first two years of the enforceable life of the patent. This cannot be true because where no independent claim is broadened, a dependent claim may be broadened in a reissue application at any time in the enforceable life of the patent. Accordingly, model answer (C) is correct and petitioner's answer (D) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 17 reads as follows:

17. In June 1997, Rene invents a circuit board device which automatically logs a computer onto the Internet without the need for entering passwords. During the prosecution of the patent for the circuit board device, Rene's patent practitioner files the following claims 1 and 2:

1. An electronic device for automatically logging onto the Internet comprising: communication means for communicating on the Internet, said communication means further comprising circuit means for automatically entering a password, and storage means for automatically storing a password for logging onto the Internet.
2. The device of claim 1 wherein the communication means is a desktop computer.

During the patent prosecution, the examiner cites as prior art a telephone with a memory, which automatically dials a telephone number. The examiner reasons that because the telephone can store the number in its memory, it would have been obvious to store a password in the memory as well. The examiner objects to claim 2 as being dependent upon a rejected claim. Being very eager to get patent protection and low on financial resources, Rene instructs the practitioner to combine claims one and two and allow the application to issue. One year and one day after issuance, Rene comes to you, a patent attorney, inquiring if her patent reads on a widely distributed, hand-held, pocket sized, portable device that is not a telephone and does not use a desktop computer to access the Internet automatically without a password, and if not, what corrective action is available. Which of the following choices is the best advice for Rene?

- (A) Since the two-year period for broadening has not expired, Rene may file a reissue with a declaration stating that the failure to claim more was due to error without deceptive intent. Rene may broaden her claims to the extent permitted by the prior art, since at no time did she narrow her claims to avoid the prior art.
- (B) Since the prior art device was a telephone, Rene is entitled to seek patent protection on all that which is not in the prior art. Rene should be able to obtain broadened patent protection by reissue of the patent.
- (C) Since Rene's original claim 1 was broadly written and since Rene narrowed her scope of patent protection by incorporating the limitations of the original claim 2 during the original prosecution, she is barred by the doctrine of recapture from enlarging her claims to the scope of the original claim 1.

(D) Although Rene narrowed her claims during the original prosecution, she can file a declaration stating that the narrowing of her claims was not because she believed the prior art precluded her from claiming more but due to financial concerns. Therefore, the narrowing of the claim was error without deceptive intent and Rene may file a reissue seeking broader claims.

(E) Rene should file a request for reexamination seeking to enlarge the scope of her patent protection.

The model answer is selection C.

Rene is barred by the recapture rule. MPEP § 1412.02. As to (A), see MPEP § 1412.02. Rene responded to a rejection by amending her claims, similar to Example B in MPEP § 1412.02, p.1400-10. As to (B), again recapture is the determinative factor. As to (D), the issue of financial concerns is of no import. As to (E) independent claims may not be broadened during a reexamination.

Petitioner argues that answer (A) is also correct. Petitioner contends that the claims may be broadened within 2 years of issue.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the claims may be broadened within 2 years of issue, the recapture rule prohibits this. The question states that Rene instructs the practitioner to combine claims one and two and allow the application to issue in response to art applied to claim 1. Rene is barred from adding back subject matter given up during prosecution to overcome art by the recapture rule. See MPEP § 1412.02. Petitioner admits that selection (C) is true. Accordingly, model answer (C) is correct and petitioner's answer (A) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 37 reads as follows:

37. An Office action was mailed in a pending patent application on Wednesday, November 17, 1999. The examiner set a three month shortened statutory period for reply. The applicant petitioned for a one-month extension of time on Thursday, February 17, 2000 and paid the appropriate one-month extension fee. No further papers or fees were submitted and the application became abandoned. What was the date of abandonment?

- (A) Friday, February 18, 2000.
- (B) Friday, March 17, 2000.
- (C) Saturday, March 18, 2000.
- (D) Monday, March 20, 2000.
- (E) Thursday, May 18, 2000.

The model answer is selection C.

The one-month extension of time filed February 17, 2000 properly extended the deadline for filing a reply to Friday, March 17, 2000. When a timely reply is ultimately not filed, the application is regarded as abandoned after midnight of the date the period for reply expired, i.e., the application was abandoned at 12:01 AM on Saturday, March 18, 2000. The fact that March 18 was a Saturday does not change the abandonment day because the reply was due on March 17, a business day. MPEP § 710.01(a).

Petitioner argues that answer (D) is correct. Petitioner contends that although (C) is technically correct, from a practical standpoint, an examiner is going to wait until Monday to count the abandonment.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that although (C) is technically correct, from a practical standpoint, an examiner is going to wait until Monday to count the abandonment, the question does not ask when the abandonment will be counted, but the date the abandonment occurs. When a timely reply is ultimately not filed, the application is regarded as abandoned after midnight of the date the period for reply expired, i.e., the application was abandoned at 12:01 AM on Saturday, March 18, 2000. Accordingly, model answer (C) is correct and petitioner's answer (D) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 43 reads as follows:

43. Which of the following definitions does not accord with proper USPTO practice and procedure relating to drawings in patent applications?

- (A) Original drawings are drawings submitted with the application when filed, and may be either formal or informal.
- (B) Formal drawings are stamped "approved" by the Draftsperson.
- (C) Drawings may be informal for reasons such as the size of reference elements.

(D) A substitute drawing is usually submitted to replace an original formal drawing.

(E) A drawing may be declared as informal by the applicant when filed.

The model answer is selection D.

A substitute drawing is usually submitted to replace an original informal drawing, not an original formal drawing. MPEP § 608.02 under the heading “Definitions.” (A), (B), (C), and (E) are wrong answers because they accord with the definitions set forth in MPEP § 608.02.

Petitioner argues that answer (B) is also correct. Petitioner contends that formal drawings may not be approved and then they are not stamped, whereas substitute drawings may replace either formal or informal drawings, particularly in PCT practice.

Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that formal drawings may not be approved and then they are not stamped, whereas substitute drawings may replace either formal or informal drawings, only formal drawings are stamped approved, selection (B) does not state that all formal drawings are so stamped, only that formal drawings are stamped approved. Substitute drawings do not replace informal drawings in domestic patent practice, formal drawings replace informal drawings in domestic practice. The instructions state “Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions.” The instructions do not indicate that a PCT application is being asked about. Accordingly, model answer (D) is correct and petitioner’s answer (B) is incorrect.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Morning question 46 reads as follows:

46. Which of the following statements regarding an applicant’s duty to submit a drawing in a U.S. patent application is true?

I. The examiner may only require a drawing where the drawing is necessary for the understanding of the invention.

II. If a drawing is not necessary for the understanding of the invention, but the case admits of illustration, the examiner may require the drawing, but the lack of a drawing in the application when filed will not affect the filing date of the application.

III. If a drawing is necessary for the understanding of an invention, but is not submitted on filing, the application cannot be given a filing date until the drawing is received by the USPTO.

- (A) I
- (B) II
- (C) III
- (D) II and III
- (E) I, II, and III

The model answer is selection D.

35 U.S.C. § 113; MPEP § 608.02(a), under heading “Handling of Drawing Requirements Under The Second Sentence Of 35 U.S.C. 113,” p.600-87. (A) is incorrect inasmuch as I is false. The examiner will normally require a drawing where the case admits of illustration. 37 C.F.R. § 1.81(c). (B) is incorrect because III is also true. (C) is incorrect because II is also true. (E) is incorrect because I is false.

Petitioner argues that answer (A) is correct. Petitioner contends that (C), (D) and (E) are incorrect because III is false because the necessity may be rendered moot and (I) is correct because it does not affect the filing date.

Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that (III) is false, because the necessity may be rendered moot, there is no reason to assume the necessity would be rendered moot. Selection (III) only applies to the case where a drawing is necessary for the understanding of an invention. Should the necessity be rendered moot, as argued by petitioner, then the condition of (III) would no longer apply and petitioner’s argument would no longer apply to (III) but to some other hypothetical circumstance beyond the scope of this question. Therefore, this argument is itself moot. Petitioner does not argue that where the necessity is not rendered moot, then (III) is incorrect. As to whether (I) affects the filing date, this argument is also moot because the question does not ask which choice affects the filing date. (I) is incorrect according to 35 U.S.C. § 113 and MPEP § 608.02(a). Accordingly, model answer (D) is correct and petitioner’s answer (A) is incorrect.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Morning question 48 reads as follows:

48. A nonprovisional patent application is filed on June 3, 1999, and on September 3, 1999, an Office action is mailed setting a 3 month shortened statutory period for reply. On March 3, 2000, a proper reply is filed together with a petition for a 3 month extension of time accompanied by the appropriate petition fee. A proper petition for conversion of the nonprovisional patent application to a provisional patent application along with the appropriate petition fee is deposited with the U.S. Postal Service as Express Mail pursuant to 37 C.F.R. § 1.10 on Saturday, June 3, 2000. Assuming the petition for conversion is granted shortly thereafter, which of the following statements is true?

- (A) The provisional application is entitled to a filing date of June 3, 1999.
- (B) The provisional application is entitled to a filing date of September 3, 1999.
- (C) The provisional application is entitled to a filing date of March 3, 2000.
- (D) The provisional application is entitled to a filing date of June 3, 2000.
- (E) None of the above.

The model answer is selection A.

Under 37 C.F.R. § 1.53(c)(2), a nonprovisional patent application “may be converted to a provisional application and be accorded the original filing date of the” nonprovisional patent application. MPEP § 601.01(c). (B), (C), and (D) are wrong because they recite dates other than the original filing date of the nonprovisional patent application. (E) is wrong because (A) is correct.

Petitioner argues that answer (E) is correct. Petitioner contends that because the application will expire immediately, it is nonsensical to ascribe a filing date to the application.

Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that because the application will expire immediately, it is nonsensical to ascribe a filing date to the application, the question asks which of the selections is true. Under 37 C.F.R. § 1.53(c)(2), a nonprovisional patent application “may be converted to a provisional application and be accorded the original filing date of the” nonprovisional patent application. MPEP § 601.01(c). Accordingly, model answer (A) is correct and petitioner’s answer (E) is incorrect.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 4 reads as follows:

4. In January 1997, Chris invents an electrical door stop for automatically stopping a door

at any position by simply pressing the doorknob downward. The doorknob is such that when carrying a large package, one may rest the package on the doorknob to stop the motion of the door. During a lunch break before completing the writing of the application for the patent on the automatic door stop, Chris' patent agent, Sam, visits a local Shack restaurant and notices a door stop which is actuated by stepping with one's foot on a mechanical lever located at the bottom of the door. Sam makes a mental note to ask a colleague as to whether he needs to disclose the doorstop at the Shack restaurant to the USPTO in conjunction with Chris' application in an information disclosure statement, but ultimately neglects to do so. Sam knows that the restaurant (and doorstop) was in existence at least one year prior to Sam's visit. In the first Office action, the only prior art uncovered by the examiner relates to stopping a door using a lever that engages a channel in the ceiling upon being pressed upward. The examiner rejects the claim asserting it would have been obvious to have either upward or downward actuating motion. In the reply to the first Office action Sam argues that the downward motion is essential because it affords the ability to actuate when one is carrying a package and that the prior art does not disclose a downwardly actuated doorstop. Following Sam's argument, the case issues. Claim 1 reads as follows:

1. A door stop for automatically stopping the pivoting action of a door by pressing downward, said door stop comprising:
 - a) first means attached to a door for receiving a downward movement;
 - b) second means for actuating a mechanism for engaging the floor surface in response to the downward movement of the first means, said first and second means being operatively connected.

Which of the following is true?

- (A) Since Sam knew of the doorstop at the restaurant and not Chris, there is no duty to disclose the Shack restaurant doorstop. An attorney need not disclose that which is within his personal knowledge in an information disclosure statement.
- (B) Since Sam discovered the Shack restaurant device after he had started writing the application, the invention was fully disclosed to Sam. There is no need to disclose that which occurs after an inventor completes his application disclosure.
- (C) Sam needs to disclose only patents or printed publications to the USPTO to satisfy the duty of disclosure. Since Sam was unaware of any patent or printed publication for the Shack restaurant doorstop, Sam does not need to file an information disclosure in this regard.
- (D) Chris should file a request for reexamination seeking to have the Shack restaurant door stop considered.

(E) None of the above.

The model answer is selection E.

Since the claim reads on a downward moving actuator and only a upward moving actuator was cited during the prosecution, the Shack restaurant device was material to the patentability of the invention. Moreover, Sam argued the significance of the downward motion feature. 37 C.F.R. § 1.56(b)(2)(i). Sam should have disclosed it under 37 C.F.R. § 1.56(c)(2). As to (A), the duty of disclosure extends to each practitioner who prepares or prosecutes the application. 37 C.F.R. § 1.56(c)(2). As to (B), even though Chris had completed the disclosure, the sighting of the Shack restaurant doorstep occurred prior to the filing date. Moreover, the restaurant (and doorstep) was in existence at least one year prior to Sam's visit. MPEP § 2001.06. As to (C), information material to the invention is more than just patents and printed publications. 37 C.F.R. § 1.56; MPEP 2001.04, p.2000-4. As to (D), only patents and printed publication may be considered during a reexamination. 35 U.S.C. § 303(a); MPEP § 2209.

Petitioner argues that answer (D) is correct. Petitioner contends that the door stop would have a printed, published instruction manual that could be used in a reexamination proceeding.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the door stop would have a printed, published instruction manual that could be used in a reexamination proceeding, selection (D) states that Chris should file a request for reexamination seeking to have the Shack restaurant door stop, not an instruction manual, considered. There is no reason to assume that an instruction manual exists or that Chris will also ask to have an instruction manual considered when the question does not anywhere mention an instruction manual. Only patents and printed publication may be considered during a reexamination. 35 U.S.C. § 303(a); MPEP § 2209. Accordingly, model answer (E) is correct and petitioner's answer (E) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 8 reads as follows:

8. In early 1998, at the request of MC Motors, Eve demonstrated her reverse automobile heating system at a testing facility in Germany. MC Motors signs a confidentiality agreement and agrees not to disclose the invention to anyone. The test is conducted in a secluded area and the persons involved are sworn to secrecy. Unbeknownst to Eve, MC Motors installs the reverse heating system on its MC cars and begins selling its cars with the reverse heating system in the United States in September 1998. In August 1999, MC files a patent application in the United States for the reverse automobile heating system. In December 1999, Eve files a patent application claiming the automobile heating system. The examiner rejects all the claims in Eve's application based upon an MC Motors brochure advertising its cars in September 1998. Which of the following is true?

- (A) Since the MC Motors misappropriated the invention and since Eve did not authorize the sale, the rejection may be overcome by showing that the sales by MC Motors were not authorized by Eve.
- (B) Eve is not entitled to a patent since the invention was on sale in this country, more than one year prior to the date of the application for patent in the United States.
- (C) MC Motors is entitled to a patent since although it misappropriated the idea for the invention from Eve, the misappropriation was beyond the jurisdiction of the USPTO.
- (D) (B) and (C).
- (E) None of the above.

The model answer is selection B.

In *Evans Cooling Systems, Inc. v. General Motors Corp.*, 125 F.3d 1448, 44 USPQ 2d 1037 (Fed. Cir. 1997) the Federal Circuit held that even though an invention is misappropriated by a third party, the public sale bar applies (35 U.S.C. § 102(b)). Accordingly, (B) is true and (A) is not. (D) is incorrect since the people at MC were not the true inventors. (E) is incorrect inasmuch as (B) is correct.

Petitioner argues that answer (D) is correct. Petitioner contends that (C) is also correct, making (D), the combination of (B) and (C), the best answer, because MC's entitlement is a practical reality from the inability of the PTO to know about the misappropriation.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that (C) is also correct because MC's entitlement is a practical reality from the inability of the PTO to know about the misappropriation, selection (C) states that the misappropriation was beyond the jurisdiction of the USPTO, which is untrue. (D) is incorrect since the people at MC were not the true inventors, 35 USC 102 is within the jurisdiction of the USPTO and therefore MC Motors is not entitled to a patent. The question does not ask whether MC Motors can obtain a patent by fraud, but rather whether MC Motors is entitled to a patent. Accordingly, model answer (B) is correct and petitioner's answer (D) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 17 reads as follows:

17. A patent application filed in the USPTO contains the following original claim:

Claim 1. A tablecloth for protecting the finish of a table comprising:
a layer of cotton;
a layer of vinyl affixed to the layer of cotton; and
a backing of felt.

Which of the following amendment(s) is/are not in accord with proper USPTO amendment practices and procedures?

- (A) In claim 1, line 3, add -with an epoxy resin-.
- (B) In claim 1, line 2, after "cotton" add -woven to have 250 threads per inch-.
- (C) In claim 1, line 3, before "layer" add -thin-.
- (D) In claim 1, line 1, correct the spelling of "tablecloth" please.
- (E) All of the above.

The model answer is selection E.

A claim may be amended by specifying the exact matter to be deleted or added, and the precise point where the deletion or addition is to be made. 37 C.F.R. § 1.121(a)(2)(i). The amendments are limited to deletions and/or additions of no more than 5 words per claim or deletions. 37 C.F.R. §§ 1.121(a)(2)(i)(A) and 1.121(a)(2)(i)(B). Here, Answer (A) is improper because the amendment does not specify the precise point where the addition is to be made. Answer (B) is improper because the amendment adds more than 5 words to the claim, and amendments by deletion and/or addition are limited to no more than 5 words per claim. Answer (C) is improper because line 3 contains the word "layer" twice and the amendment does not specify whether the word "thin" is to be

added before the first occurrence, second occurrence, or all occurrences of the word "layer." Answer (D) is improper because the amendment does not specify the exact matter to be deleted and the exact matter to be inserted.

Petitioner argues that answer (A) is correct. Petitioner contends that examiners and docket clerks would routinely enter amendments such as in (B), (C) and (D).

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that examiners and docket clerks would routinely enter amendments such as in (B), (C) and (D), the question asks which of the following amendment(s) is/are not in accord with proper USPTO amendment practices and procedures. Answer (B) is improper because the amendment adds more than 5 words to the claim, and amendments by deletion and/or addition are limited to no more than 5 words per claim. Answer (C) is improper because line 3 contains the word "layer" twice and the amendment does not specify whether the word "thin" is to be added before the first occurrence, second occurrence, or all occurrences of the word "layer." Answer (D) is improper because the amendment does not specify the exact matter to be deleted and the exact matter to be inserted. Accordingly, model answer (E) is correct and petitioner's answer (A) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 20 reads as follows:

20. Assuming that A, B, C, and D are known materials, which if any of the following claims, included in Bill's application, would not be properly rejected pursuant to 35 U.S.C. 112, second paragraph?

Claim 1. A composition produced by the steps of: mixing one part A by weight with three parts B by weight at 20 degrees Celsius to form a mixture of A and B; heating the mixture of A and B to 100 degrees Celsius; and adding six parts C by weight to the mixture of A and B.

Claim 2. A composition for bonding asphalt shingles to wood sheathing, comprising 10% A, 30% B, and 60% C.

Claim 3. A composition produced by the steps of: mixing one part A by weight with three parts B by weight at 20 degrees Celsius to form a mixture of A and B; heating the mixture of A and B to 100 degrees Celsius; adding six parts C by weight to form a mixture of A, B, and C; cooling the mixture of A, B, and C to 20 degrees Celsius; and adding an effective amount of D.

- (A) Claim 1.
- (B) Claim 2.
- (C) Claim 3.
- (D) Claims 1 and 2.
- (E) None of the above.

The model answer is selection D.

Claims 1 and 2 are drawn to a naturally occurring composition but do not provide the basis for a rejection under 35 U.S.C. § 112, second paragraph, even though they do provide the basis for a rejection under 35 U.S.C. § 101. MPEP § 2105. Therefore (A) and (B) are incorrect. Claim 3 is indefinite because it recites an “effective amount” without stating the function to be achieved. MPEP § 2173.05(c). Therefore (C) is incorrect. (E) is incorrect because (D) is correct.

Petitioner argues that answer (E) is correct. Petitioner contends that all of claims 1, 2 and 3 would not be properly rejected under 35 USC 112, stating that his answer agrees with respect to claims 1 and 2, and that as a practical matter, examiners simply would not reject claim 3.

Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that all of claims 1, 2 and 3 would not be properly rejected under 35 USC 112, stating that his answer agrees with respect to claims 1 and 2, and that as a practical matter, examiners simply would not reject claim 3, selection (E) states that none rather than none of the claims would not be properly rejected. That is, selection (E) states that all of the claims would be properly rejected. Petitioner has not argued that this is the case and has in fact argued exactly the opposite. As to claim 3, it is indefinite because it recites an “effective amount” without stating the function to be achieved. MPEP § 2173.05(c). Accordingly, model answer (D) is correct and petitioner’s answer (E) is incorrect.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 40 reads as follows:

40. Stan, through a registered practitioner, files an application for a patent. During the prosecution of Stan’s patent, in an amendment, the practitioner admitted in his discussion as to “all the claims” of Stan’s application, that “the most pertinent available prior art known to the Applicants and their representatives is the Acme Patent, cited by the examiner.” Within one year after the patent issues, Stan comes to you and wants to file a reissue to broaden his claims, based on the fact that the Acme patent is not prior art. He

has ample evidence to show that he conceived and reduced his invention to practice before the filing date of the Acme patent. Which of the following is true?

- (A) Stan should file a reissue application accompanied by a declaration under 37 C.F.R. 1.131 to swear behind the date of the Acme reference. The statement by the registered practitioner, who formerly represented Stan, that the Acme patent was prior art constituted error without deceptive intent and may be corrected by reissue.
- (B) Stan should file a request for reexamination and submit the Acme patent along with evidence in the form of affidavits or declarations showing that the Acme patent is not prior art.
- (C) The explicit admission by registered practitioner, who formerly represented Stan, that the Acme patent constituted prior art is binding on Stan in any later proceeding involving the patent.
- (D) Since Acme patent was cited by the examiner and not by the registered practitioner, who formerly represented Stan, Stan can not be held accountable for the error. Moreover, the statement by was directed to the pertinence of the prior art and not to the issue of whether the date of the Acme patent could be sworn behind. Accordingly, the statement has no binding effect.
- (E) (A) and (D).

The model answer is selection C.

Admissions by applicant constitute prior art. As explained in *Tyler Refrigeration v. Kysor Industrial Corp.*, 777 F.2d 687, 227 USPQ 845 (Fed. Cir. 1985), the Fed. Circuit found that the district court decided on two separate and independent grounds that the Aokage patent was such prior art. One basis was Tyler's admission of the Aokage reference as prior art before the PTO during the prosecution of the '922 Subera patent. The court found that, in a wrap-up amendment, the Tyler attorney admitted in his discussion as to "all the claims" of the three Subera applications, that "the most pertinent available prior art known to the Applicants and their representatives is the Aokage U.S. Patent 4,026,121 cited by the Examiner" (emphasis added). In view of this explicit admission, the district court's decision was proper and was sufficiently based on clear and convincing evidence. The controlling case law in this court recognizes this principle. See *Aktiebolaget Karlstads Mekaniska Werkstad v. ITC*, 705 F.2d 1565, 1574, 217 U.S.P.Q. (BNA) 865, 871 (Fed. Cir. 1983); *In re Fout*, 675 F.2d 297, 300, 213 U.S.P.Q. (BNA) 532, 536 (CCPA 1982), and *In re Nomiya*, 509 F.2d 566, 571, 184 U.S.P.Q. (BNA) 607, 612 (CCPA 1975). Thus, we must affirm the court's decision that the Aokage patent was prior art and as such binding on Tyler. (Here again, we do not pass on the other grounds

on which the court concluded that the Aokage was prior art within the meaning of 35 U.S.C. § 102.) Since (C) is true, (D) is not true. Answers (A), (B) and (D) also are not true since the Acme patent can not be sworn behind or otherwise removed as a result of the admission. (E) is not true because (A) and (D) are not true.

Petitioner argues that answer (A) is correct. Petitioner contends that the Tyler case, upon which (C) depends, is outside the scope of the MPEP and therefore cannot be the basis for a correct answer, and further, that were the admission based on error, it would hardly sound proper.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the Tyler case, upon which (C) depends, is outside the scope of the MPEP and therefore cannot be the basis for a correct answer, and further, that were the admission based on error, it would hardly sound proper, the instructions state "The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the Official Gazette." Tyler modified the rules of admissions as prior art and is applicable patent law within the scope of the examination. Whether a hypothetical sounds proper is not a policy, practice, or procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the Official Gazette upon which examination answers may be selected according to the explicit instructions. Accordingly, model answer (C) is correct and petitioner's answer (A) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 43 reads as follows:

43. An article in a popular scientific journal, dated January 13, 1998, fully discloses and teaches how to make a "Smart Shoe" wireless telecommunications device. The article discloses a shoe having a dialer in a rubber sole of the shoe. The article does not teach or suggest using a metallic shoelace as an antenna or for any other purpose. Which of the following claims in an application filed January 20, 1999 is/are anticipated by the journal article, and is/are not likely to be properly rejected under 35 U.S.C. § 112, second paragraph as indefinite?

Claim 1. A telecommunications device comprising: a shoe having a rubber sole; a dialer in the rubber sole; and optionally a metallic shoelace.

Claim 2. A telecommunication device comprising: a shoe having a rubber sole; a dialer in the rubber sole; and a metallic shoelace.

Claim 3. A telecommunication device comprising: a shoe having a rubber sole; a dialer in the rubber sole; and optionally a random access memory for storing telephone numbers.

- (A) Claim 1.
- (B) Claim 2.
- (C) Claim 3.
- (D) Claims 1 and 3.
- (E) None of the above.

The model answer is selection D.

MPEP § 2173.05(h). Ex Parte Cordova, 10 USPQ2d 1949 (Bd. Pat. App. & Inter. 1989) and 35 U.S.C. § 102(b). (B) is incorrect since the article does not disclose a metallic shoelace. Since the “optional” element does not have to be disclosed in a reference for the claim to be anticipated, claims 1 and 3 are each anticipated by the article. Thus, (A), (C), and (E) are incorrect.

Petitioner argues that answer (E) is correct. Petitioner contends that the shoe laces and random access memory are lost in space, lacking structural connection to the shoes, and therefore indefinite.

Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that the shoe laces and random access memory are lost in space, lacking structural connection to the shoes, and therefore indefinite, petitioner does not give any reason as to why the claims lack structural connection. One of ordinary skill would immediately apprehend how shoelaces relate to shoes and how random access memory relates to a dialer. Claims need not explicitly recite that which is known to those of ordinary skill in the art. Accordingly, model answer (D) is correct and petitioner’s answer (E) is incorrect.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

ORDER

For the reasons given above, one point has been added to petitioner's score on the Examination. Therefore, petitioner's score is 67. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

A handwritten signature in black ink, appearing to read 'Robert J. Spar', is written above a horizontal line.

Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy